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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,853	01/26/2006	Yukitaka Shimizu	19070230PUS1	8106
2292 7590 08/06/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER MUHAMMAD, KHALIF R				
ART UNIT 3685		PAPER NUMBER		
NOTIFICATION DATE 08/06/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/565,853

**Applicant(s)**

SHIMIZU ET AL.

**Examiner**

KHALIF MUHAMMAD

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14, 16, 17, 20-23, 29, 30 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 16, 17, 20-23, 29, 30, 34 and is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 14, 16, 17, 20-23, 29, 30, 34 and 35 have been examined and rejected.

### ***Response to Arguments***

2. Applicant's election with traverse of accounting system in the reply filed on March 24, 2009 is acknowledged. The traversal is on the ground(s) that the restriction is required under 35 U.S.C. 121 and 372.
3. This is not found persuasive because the inventions are distinct, each from the other because of the following reasons: Inventions I-V are related subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as billing in a video distribution system. Invention II has separate utility such as for transmission. Invention III has separate utility such as dispensing. Invention IV has separate utility such as transmitting privileges to a computer on a local network. Invention V has separate utility such as wherein a video signal which is copy protected is supplemented by a unique identifier of a source or picture signal.
4. The requirement is still deemed proper and is therefore made FINAL.
5. Applicant's arguments filed 3/24/2009 have been fully considered but they are not persuasive.

6. Applicant's arguments with respect to claims 14, 16, 17, 20-23, 29, 30, 34 and 35 have been considered but are moot in view of the new ground(s) of rejection.

***Examiner Comment***

7. There is an excessive amount of "intended use" in the claims. For example the language subsequent to "structurally arranged" in claim 14 is intended use and it has been held that the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform (MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 34 and 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 34 and 35 are directed to an "accounting system". Specifically, Claim 34 recites a computer-readable recording medium physically recording thereon a computer program for controlling an accounting system. However, this is merely software, and it has been held that software without a required computer-readable medium-storing the software that, when executed, causes the computer to perform a particular process or method (MPEP 2106.01) is merely nonfunctional descriptive material and non-statutory under 35 U.S.C. 101.

Claim 35 is also rejected as it recites similar language to claim 34.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 14, 16, 17, 20-23, 29, 30, 34 and rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

11. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

12. For purposes of examination claim 14 will be interpreted as follows:

- a license server connected to an accounting server
- a content reproduction device
- wherein the license server is structurally arranged to receive the content ID and the accounting ID from the content reproduction device and to transmit an accounting amount obtained from the received content ID and the accounting ID to the accounting server.

13. Claim 14 recites *when the remaining amount of money information corresponding.....the accounting server subtracts.....to the license server that upon*

*receipt.....determines.....will be provided;*—however this is considered a method step and it has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved. (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990))

14. Claim 21 recites *wherein the accounting ID and/or the decoding information are provided with an expiration date*, however this is considered a method step and it has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved. (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990))

15. Claim 23 recites *wherein the license server records the number of times of usage for each content ID as a usage history*, however this is considered a method step and it has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved. (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990))

16.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 14, 16, 17, 20-23, 29, 30, 34 and 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiguro (US 7,216,368).

19. Referring to Claims 14,16,34 and 35 Ishiguro teaches an accounting system comprising:

- a license server connected to an accounting server (fig 1)
- a content reproduction device (fig 1; col 7 lines 1-3)
- wherein the license server is structurally arranged to receive the content ID and the accounting ID from the content reproduction device and to transmit an accounting amount obtained from the received content ID and the accounting ID to the accounting server. (col 7 lines 50-60),

20. With respect to claim 17, Ishiguro discloses the accounting system of claim 16, but does not specifically disclose wherein when a content ID of an encrypted content to be reproduced does not exist in the license card, the content reproduction device

records the content ID into the license card. However Ishiguro does disclose user information being recorded on an appropriate storage medium (column 19 lines 55-60) and additionally it has been held that language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.( *MPEP §2106 II C*)

21. Referring to Claim 20, Ishiguro teaches the accounting system of claim 14, wherein the communication network is structurally arranged to exchange encrypted data between at least the content reproduction device and the license server (col 2 lines 1-10).

22. With respect to claim 21, Ishiguro discloses the accounting system of claim 14, wherein the accounting ID and/or the decoding information are provided with an expiration date. (fig 8. col 9 lines 40-52)

23. Referring to Claim 22, Ishiguro teaches the accounting system of claim 14, wherein the license server is further structurally arranged to record a content ID of a content used for each accounting ID as a usage history (col 11 lines 5-15; col 24 lines 47-51).



24. With respect to claim 23, Ishiguro discloses the accounting system of claim 22, wherein the license server records the number of times of usage for each content ID as a usage history. ( col 11 lines 5-15; col 24 lines 47-51)

25. Referring to Claim 29, Ishiguro teaches the accounting system of claim 16, wherein the communication network is structurally arranged to exchange encrypted data between at least the content reproduction device and the license server (col 2 lines 1-10).

26. Referring to Claim 30, Ishiguro teaches the accounting system of claim 17, wherein the communication network is structurally arranged to exchange encrypted data between at least the content reproduction device and the license server.( col 2 lines 1-10)

### ***Conclusion***

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHALIF MUHAMMAD whose telephone number is (571)270-5207. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hewitt Calvin can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KHALIF MUHAMMAD/  
Examiner, Art Unit 3685

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685